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**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: A8643

Yudong SUN

Appln. No.: 09/512,560

Group Art Unit: 2178

Confirmation No.: 6032

Examiner: Adam L. BASEHOAR

Filed: February 24, 2000

For: SERVER-SIDE HTML CUSTOMIZATION BASED ON STYLE SHEETS AND  
TARGET DEVICE

**REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41**

**MAIL STOP APPEAL BRIEF - PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits  
this Reply Brief in response to the Examiner's Answer dated April 18, 2006. Entry of this Reply  
Brief is respectfully requested.

**Table of Contents**

STATUS OF CLAIMS .....	2
GROUND OF REJECTION TO BE REVIEWED ON APPEAL .....	3
ARGUMENTS .....	4
CONCLUSION .....	11

**STATUS OF CLAIMS**

Claims 1-30 are all the claims pending in the application and are the claims on appeal herein.

Claim 11 is rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over W3C's "Introduction to CSS2," (<http://www.w3.org/TR/REC-CSS2/intro.html#processing-model>); hereinafter "*Intro to CSS2*") in view of *Traughber et al.* (WO 98/14896, hereinafter "*Traughber*").

**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

1. Whether or not claim 11 is unpatentable under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
2. Whether or not claims 1-30 are unpatentable over *Intro to CSS2* in view of *Traughber*, under 35 U.S.C. § 103(a).

## **ARGUMENTS**

### **1. Rejection Under 35 U.S.C. § 101**

Claim 11 is rejected under 35 U.S.C. § 101, as allegedly not being tangibly embodied. The Examiner continues to justify the rejection by pointing to the disclosure found in Applicant's Specification which states that the modules recited in claim 11 may be implemented in software alone (See Examiner's Answer: pages 7-8).

However, even in the face of such disclosure in the Specification, Applicant respectfully submits that claim 11 *as a whole* is directed to a patentable subject matter. The Examiner seems to be suggesting that if the claimed elements can be implemented in software alone, the claim as a whole is *per se* unpatentable. Nevertheless, Applicant respectfully points out that such suggestion of the Examiner cannot be substantiated under the 35 U.S.C. § 101 jurisprudence.

The standard for determining patentable subject matter is not whether the claim can be implemented using software, but whether the claimed invention as a whole produces a "useful, concrete and tangible result." *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373; 47 USPQ2d 1596, 1601 (Fed. Cir. 1998).

As extensively pointed out thus far, claim 11 is directed to a system that transforms data to produce a useful, concrete and tangible result. For example, claim 11 recites "[a] system for customizing a requested document." The claim further recites, for example, a flattening module configured to flatten the DOM to generate therefrom a corresponding transformed document suitable for display by the target device." Generating the transformed document produces a useful, concrete and tangible result since the transformed document is suitable for display on the

target device. Further, claim 11 as a whole is directed to a *system* that includes *several modules*, namely, a parsing module, a style sheet access module, a style sheet application module, and a flattening module where each module produces a useful, concrete and tangible result. Therefore, Applicant respectfully submits that claim 11 is directed to a patentable subject matter at least because it is directed to a system that transforms data producing a useful, concrete and tangible result.

Further, the Examiner alleges that the elements of the system of claim 11 represent functional descriptive material (See Examiner's Answer: page 7). Applicant respectfully disagrees. Claim 11 is directed to a *system* that includes *modules*, and as such, is distinguishable from claims involving mere data structures and computer programs which make up functional descriptive material<sup>1</sup>, as asserted by the Examiner. That is, the claimed *modules* show a sufficient measure of integration of data elements with the physical structure of the hardware.

As such, Applicant respectfully submits that the claimed modules are much more than "data structures" which merely describe physical or logical relationships among data elements. For example, the parsing module recited in claim 11 demonstrates that the claimed module is more than mere abstract description of logical relationship among data elements. Assuming an embodiment of the parsing module is implemented in software, such a parsing module is not configured to parse the document to generate a corresponding DOM until that software is

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<sup>1</sup> Relevant portion of the MPEP clearly states: "Functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions. (See: MPEP § 2106 IV. B. 1.)

installed into a computer implemented device, such as a computer readable memory device, as discussed in the specification at page 10, line 13 through page 11, line 13.

Accordingly, Applicant respectfully disagrees that the *system* of claim 11 is mere functional descriptive material, as the claim requires specific configurations of various *modules* that must be tangibly embodied in a computer memory, for example, to produce useful, concrete and tangible results in the claim.

With respect to the Examiner's assertion that the modules recited in claim 11 are merely "configured" to achieve an end, and therefore do not produce a tangible, useful and concrete result, Applicant respectfully disagrees. It appears that the Examiner is ignoring the fact that claim 11 is directed to a *system* claim. The Examiner compares the modules of claim 11 with the processes recited in claim 1. However, Applicant respectfully submits that claim 1 is directed to a *method* claim and therefore is not pertinent to the issue of whether the modules in a *system* claim produce a useful, concrete and tangible result.

Further, Applicant respectfully submits that a *system* comprising *modules which are specifically configured* to achieve a tangible result achieves the result the system is configured to achieve. A system is a type of machine, and therefore, the system may be in a state that is not active at times. However, just as an inactive machine configured to achieve a useful, concrete and tangible result achieves such result when the machine is active, the system of claim 11 comprising modules each specifically configured to produce a result produces useful, concrete and tangible result. Therefore, Applicant respectfully submits that the Examiner's assertion that the modules embody mere inactive steps cannot be substantiated.

In view of all the foregoing, the Board is respectfully requested to reverse the rejection of claim 11 under 35 U.S.C. § 101.

**2. Rejection Under 35 U.S.C. § 103 (a)**

Claims 1-30 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over W3C's "Introduction to CSS2" (hereinafter "*Intro to CSS2*") in view of Traughber et al. (hereinafter "Traughber").

***Intro to CSS2 and Traughber Fails to Teach or Suggest All of the Claim Elements***

Each of the independent claims 1, 11 and 21 recites, *inter alia*, "applying the at least one rule of the style sheet to the DOM." These claims also unambiguously recite that such application of the style sheet takes place *within a document server*. The Examiner admits that the primary reference *Intro to CSS2* fails to teach or suggest the features noted above. However, the Examiner continues to assert that the secondary reference Traughber makes up for the deficiencies of *Intro to CSS2*. Applicant respectfully disagrees, and submits that *Intro to CSS2* and Traughber, either alone or in combination, fail to teach or suggest the features of independent claims 1, 11 and 21 noted above.

Thus far, the Examiner has stated the following regarding the cited prior art references (See Examiner's Answer: page 9). First, the secondary reference Traughber fails to teach or suggest any particular use of *style sheets*, and second, Traughber is not being cited for showing the use of style sheets, but for allegedly teaching that "server side document customization processing was notoriously well known in the art at the time of the invention."

With respect to the Examiner's first statement, Applicant hereby respectfully submits that the statement effectively amounts to an admission that both *Intro to CSS2* and Traugher fail to teach or suggest "applying the at least one rule of the *style sheet* to the DOM" at the *server* side, as recited in each of the independent claims 1, 11 and 21. Applicant points out that the Examiner has repeatedly conceded this point, and it has been long established that the only use of the style sheet is found at the user agent (i.e. client side), as described in the primary reference *Intro to CSS2* (See Examiner's Answer: page 9).

With respect to the Examiner's second statement, Applicant respectfully submits that even if Traugher could be read as somehow teaching that server side document customization processing was notoriously well known, the combined references would *still* fail to teach or suggest "applying the at least one rule of the *style sheet* to the DOM" at the server end, as recited in the independent claims. The fact<sup>2</sup> that the use of style sheets are described in the primary reference *Intro to CSS2* is completely unavailing in reaching the conclusion the Examiner attempts to reach, as *Intro to CSS2* only describes the use of style sheets at the *client* end. In order to make a prima facie rejection under 35 U.S.C. § 103 (a), the Examiner must clearly show that *each and every element* of the claim is taught in the cited prior art references. However, in the current instance, there is simply no teaching or suggestion whatsoever in either *Intro to CSS2* or Traugher regarding application of at least one rule of the style sheet to the DOM at the *server side*.

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<sup>2</sup> Regarding the use of the style sheet, the Examiner states that "said feature had already been established in the *Intro to CSS2* reference" (See Examiner's Answer: page 9).



Applicant respectfully submits that it is of no relevance in the current rejections whether Traughber generally describes server side documentation processing, as continuously alleged by the Examiner. What is relevant, however, is the undisputed fact that Traughber fails to teach or suggest the use of style sheets on the server side, as recited in the independent claims.

Therefore, neither Intro to CSS2 nor Traughber teaches or suggest the use of style sheets at a server side, and even if the references could be combined as asserted by the Examiner, the combination would still be missing this feature.

**No Motivation to Combine the References in the Manner Suggested by the Examiner**

The Examiner continues to assert that the rationale for combining the two references are premised on broad general notions that “Traughber teaches server side (Fig. 2: 32) document processing for a requesting client browser” and “Traughber teaches the benefit of server side document customization being that the processing load of the customization was located on the server side and not resident on the client” (See Examiner’s Answer: page 11, lines 8-12). However, such rationale for combining the references are not pertinent to the rejections at hand, since Traughber fails to teach or suggest any particular application of style sheets at either the client or server side, let alone any reason why the application of style sheets should occur on the server side.

Applicant again points out that such general processing of web pages on the server side is not pertinent to the application of style sheets which is the issue at hand, and therefore, cannot supply the requisite motivation for combining the two references. Style sheets are a specific

technique used for customizing a web page for various display devices, and Traughber simply does not recognize that its HTML page can be modified for different display devices.

Lastly, the Examiner contends that “additional notoriously well known benefits outside of the applied prior art of server side processing based on a user target device” have been presented previously (See Examiner’s Answer: page 11-12). The Examiner cites the Final Office Action dated April 21, 2004 as evidence of such presentation. Applicant respectfully submits that the rejections under 35 U.S.C. § 103 (a) found in the Final Office Action of April 21, 2004 were under entirely different references and rationale than the ones under appeal in the instant case. In any event, Applicant fully responded to the rejections, and the Examiner found the arguments persuasive to withdraw all the rejections found in the Final Office Action of April 21, 2004 (See Non-Final Office Action of March 7, 2005; page 6).

Therefore, Applicant respectfully submits that the Examiner has not established the requisite motivation to combine the references as he alleges. That is, the Examiner fails to identify any particular reason, supported by the applied references, why one of ordinary skill in the art at the time of the invention would have been motivated to change *Intro to CSS2’s* client side application of style sheets to a modified system where style sheets are applied at a server side, in view of disclosure in Traughber.

In view of all the foregoing, Applicant respectfully submits that the Examiner has not set out a prima facie case of obviousness.

**Reply Brief Under 37 C.F.R. § 41.41**  
U.S. Application No.: 09/512,560

Attorney Docket No.: A8643

**CONCLUSION**

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,



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**23373**

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